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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR                 | ATTORNEY DOCKET NO.         | CONFIRMATION NO.       |
|---|-------------|--------------------------------------|-----------------------------|------------------------|
| 10/806,070  | 03/22/2004  | Johannes Theodorus Maria Slingerland | VER-180XX                   | 1513                   |
| 207 7590 07/16/2007<br>WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP<br>TEN POST OFFICE SQUARE<br>BOSTON, MA 02109 |             |                                      | EXAMINER<br>NGUYEN, TRINH T |                        |
|   |             |                                      | ART UNIT<br>3644            | PAPER NUMBER           |
|   |             |                                      | MAIL DATE<br>07/16/2007     | DELIVERY MODE<br>PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/806,070 | <b>Applicant(s)</b><br>SLINGERLAND ET AL. |  |
|                              | <b>Examiner</b><br>Trinh T. Nguyen   | <b>Art Unit</b><br>3644                   |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Amendment dated 4/30/07.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 12, 15, 17-19, 21-38 and 40 is/are pending in the application.
- 4a) Of the above claim(s) 23-26, 31-38 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12, 15, 17-19, 21, 22, 27-30, 42, 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2, 18, 27 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, it is not clear in the specification how “a portion of the inner box projects through one of the upper or lower sides of the second inner box holder” (as claimed in claim 2); and it is not clear in the specification how “the inner box is configured to extend substantially outside of the first inner box holder is the second relation position” (as claimed in claims 18 and 27).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 18, 27 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2 and 29, it is not clear in the specification how “a portion of the inner box projects through one of the upper or lower sides of the second inner box holder” and therefore, it is not understood what is being claimed.

In claims 18 and 27, it is not clear in the specification how “the inner box is configured to extend substantially outside of the first inner box holder is the second relation position” and therefore, it is not understood what is being claimed.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,2,4-6,12,17,18,21,28-30,42, and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by JP1-108926 (JP'926).

For claim 1, JP'926 discloses a flower box assembly comprising an inner box (1) and a first inner box holder (2), the inner box having a bottom wall and at least one closed sidewall, and being configured to be at least partly fillable with water, the first inner box holder having at least one sidewall and an open lower side and upper side, wherein the inner box and the first inner box holder are configured to be detachably coupled with each other with a press fit.

For claim 2 (as best understood), JP'926 further discloses a second inner box holder having at least one sidewall and an open lower side and upper side and configured to permit the inner box to be accommodated within the second inner box holder, and positionable in relation to the inner box such that a portion of the inner box projects through one of the upper or lower sides of the second inner box holder, the first inner box holder being operable to support the second inner box holder when

configured to have the second inner box holder rests on the upper side of the first inner box holder (it is noted that JP'926 teaches a plurality of inner box holders and inner boxes and therefore, there will be a second inner box holder and that the second inner box holder is configured to permit the inner box to be accommodated within the second inner box holder and positionable in relation to the inner box such that a portion of the inner box projects through one of the upper or lower sides of the second inner box holder and wherein the first inner box holder being operable to support the second inner box holder when configured to have the second inner box holder rests on the upper side of the first inner box holder).

For claims 4, 21 and 22, JP'926 further discloses that at least one sidewalls of the first and second inner box holders taper towards each other in the direction of one of the lower or upper sides, such that the first and second inner box holders are configured to be nestable within each other.

For claim 5, JP'926 further discloses that at least one sidewall of the inner boxes tapers inward from the upper side to the lower side, such that the inner box is configured to be nestable within another inner box.

For claim 6, JP'926 further discloses that in the at least one sidewall of the first inner box holders, at least one light passage opening (4).

For claim 12, JP'926 further discloses the second and first inner box holders with lower edges (2b), wherein the lower edges being configured such that the first and second inner box holders placed onto each other by their lower edges form a cooperative engagement for stable stacking.

For claim 17, JP'926 further discloses the inner box (1) is configured to be detachably coupled with the first inner box holder (2) when the first inner box holder is in a first relative position in relation to the inner box, and the inner box is also configured to be detachably coupled with the first inner box holder when the first inner box holder is in an inverted, second relative position in relation to the inner box.

For claim 18 (as best understood), JP'926 further discloses the inner box is configured to extend within the first inner box holder in the first relative position, and the inner box is configured to extend outside of the first inner box holder in the second relative position.

For claim 28, JP'926 further discloses the inner box (1) is configured to permit placement in the first inner box holder (2); and the inner box is configured to be detachably coupled with the first inner box holder with a circumferential projection (5).

For claim 29 (as best understood), JP'926 further discloses a circumferential projection (5) on an end of the inner box (1) which is configured to engage an edge of the second inner box holder when the portion of the inner box projects through one of the upper or lower sides of the second inner box holder.

For claim 30, JP'926 further discloses a second inner box holder, which is shaped and sized to permit the second inner box holder to be placed in an inverted orientation on an upper side of the inner box, or on the upper side of the first inner box holder, wherein the first inner box holder is shaped and sized to permit the first inner box holder to be placed atop the second inner box holder.

Art Unit: 3644

For claim 42, JP'926 further discloses a container (1) having a closed end, an open end and a sidewall between the closed end and open end; a fastener component (5) on a perimeter of the open end; and a container holder (2) having two open ends, one of the open ends having an engagement structure (7) being cooperative with the fastener component to detachably secure the container and the container holder together when the container and container holder have respective positions to permit the fastener component to cooperatively engage the engagement structure.

For claim 43, JP'926 further discloses the fastener component and the engagement structure cooperatively engage each other with a press fit.

It is noted that the claim language uses functional language of "configured to"; so, as long as the first and second box holders and the inner box of JP'926 have the similar structures to those of Applicant's invention, which they do, then it is "configured to" (or capable of) perform such functions similar to those of Applicant's invention.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 19 and 27 (as best understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over JP1-108926 (JP'926).

Art Unit: 3644

As described above, JP'926 discloses most of the claimed invention except for mentioning that the second inner box holder differs in size or shape from the first inner box holder.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that whether the second inner box holder is different from or the same as the first inner box holder is a matter of design choice wherein no significant problem is solved or unexpected result obtained, and it appears that the invention would perform equally well with the first and second inner box holders such as one taught by JP'926.

As described above, JP'926 discloses most of the claimed invention except for mentioning that the engaging force is greater than a weight of the first inner box holder.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified JP'926's assembly so as to include an engaging force that is greater than a weight of the first inner box holder, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. Also, since applicant did not provide a reason and/or showing any criticality as to why the engaging force has to be greater than a weight of the first inner box holder, it is believe that through trial and error during the constructing process that one comes up with a desirable engaging force to meet the design criteria.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP1-108926 (JP'926) in view of US 5042674.



Art Unit: 3644

As described above, JP'926 discloses most of the claimed invention except for mentioning that the lower edge of the first inner box holder is provided with at least one toothed provision.

US 5042674 teaches a concept of using toothed provisions (38,50) in containers so as to form a cooperative engagement between the containers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the assembly of JP'926 so as to include a plurality of toothed provisions on the lower edge of the first inner box holder, in a similar manner as taught in US 5042674, so that the holder can be attached to another holder more securely.

### ***Response to Arguments***

10. Applicant's arguments filed 4/30/07 have been fully considered but they are not persuasive.

11. In response to applicant's argument that neither the containers 1 or 2 of JP'926 are capable of being filled with water, they cannot perform the function of containing water, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

12. Applicant argues that JP'926 fails to disclose a second inner box holder coupled to the inner box or used in conjunction with the inner box and the first inner box holder, Applicant's argument has been noted. However, it is noted that JP'926 teaches a plurality of inner box holders and inner boxes and therefore, there will be a second inner

Art Unit: 3644

box holder and that the second inner box holder is configured to permit the inner box to be accommodated within the second inner box holder and positionable in relation to the inner box and wherein the first inner box holder being operable to support the second inner box holder when configured to have the second inner box holder rests on the upper side of the first inner box holder. Furthermore, it is noted that the claim language uses functional language of "configured to"; so, as long as the first and second box holders and the inner box of JP'926 have the similar structures to those of Applicant's invention, which they do, then it is "configured to" (or capable of) perform such functions similar to those of Applicant's invention.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3644

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh T. Nguyen whose telephone number is (571) 272-6906. The examiner can normally be reached on M-F (9:30 A.M to 6:00 P.M). The examiner's supervisor, Teri Luu can be reached on (571) 272-7045 for the purpose of status inquiry only. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Trinh T Nguyen  
Primary Examiner  
Art Unit 3644

7/6/07